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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,764	08/09/2001	Dusan Miljkovic	700.15-US1	5911

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EXAMINER

LEWIS, PATRICK T

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 12/11/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,764

Applicant(s)

MILJKOVIC, DUSAN

Examiner

Patrick T. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

The indicated allowability of claims 13-20 is withdrawn. Prosecution on the merits of this application is reopened on claims 13-20, which are considered unpatentable for the reasons set forth below.

Applicant is advised that the Notice of Allowance mailed is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

Rejections Set Forth in the Office Action dated November 20, 2002

Claims 1-20 were rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 6,080,425 to MILJKOVIC.

Examiner's Amendment of May 5, 2003

In the Examiner's Amendment set forth in the Office Action mailed May 5, 2003, claims 1-12 were cancelled. Claim 18 was amended.

Response to the Amendment filed February 12, 2003

In the amendment filed February 12, 2003, claim 1 and 13 were amended.

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An action on the merits of claims 13-20 is contained herein below.

In regards to the Rejection of claims 13-20 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 6,080,425 to MILJKOVIC, Applicant's amendments filed February 12, 2003 have been fully considered but they are not persuasive. The Rejection of claims 13-20 is maintained for the reasons of record as set forth in the Office Action dated November 20, 2002.

Response to Arguments

Applicant's arguments filed February 12, 2003 have been fully considered but they are not persuasive.

In response to the argument that MILJKOVIC does not disclose the collagenase activity of the boron-containing compound, but rather teaches only that the boron-containing compounds increase the synthesis of collagen, it is noted that the collagenase activity is an inherent property of the boron-containing compounds. The co-extensive patient population, similar compositions employed and the similar end uses envisioned indicate that the methods of MILJKOVIC are necessarily present as the compositions would be expected to exhibit similar properties. Therefore, though MILJKOVIC does not disclose the collagenase activity of the boron-containing compounds, this is a quantification of an inherent property of the boron-containing compounds. As the Office is not equipped to perform such testing, the burden of proof rests upon the applicant to show an actual difference in the properties observed.

The mere failure of a reference to disclose all the advantages asserted by applicant is not a substitute for actual differences in properties. In re DeBlauwe, 22 USPQ 191. An apparently old composition cannot be converted into an unobvious one simply by the discovery of a

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characteristic one cannot glean from the cited prior art. *Titanium Metals Corp. v. Banner*, 227 USPQ 773.

Accordingly, the burden of proof is upon the Applicant to show that the instantly claimed subject matter is different from and unobvious over that taught by the prior art relied upon. In re Brown, 173 USPQ 65, 689; In re Best, 195 USPQ 430; In re Marosi, 21 USPQ 289, 293.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 13-20 are rejected under 35 U.S.C. 102(b) as being anticipated by MILJKOVIC.

MILJOKOVIC discloses a cosmetic composition comprising a boron complex in a suitable solvent system, in a microemulsion or macroemulsion, or in a suitable liposome form (com. 3, lines 10-14). The boron is complexed with fructose, sorbose, mannitol, sorbitol, xylitol, ascorbic acid, serine or theonine (col. 2, lines 49-63). The compositions are preferably adapted for efficient penetration through the skin stratum corneum barrier when applied topically (col. 3, lines 16-18). The compositions are to be rubbed onto the skin several times per day (col. 5, lines 19-28) to reduce skin wrinkles (col. 2, lines 37-42).

While MILJKOVIC does not disclose the compositions as being collagenase inhibitors, this property is considered an inherent property of the boron-containing compound, as set forth supra. The co-extensive patient population, similar compositions employed and the similar end uses envisioned indicate that the methods of MILJKOVIC are necessarily present as the compositions would be expected to exhibit similar properties. Therefore, though MILJKOVIC

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does not disclose the collagenase activity of the boron-containing compounds, this is a quantification of an inherent property of the boron-containing compounds. As the Office is not equipped to perform such testing, the burden of proof rests upon the applicant to show an actual difference in the properties observed.

The mere failure of a reference to disclose all the advantages asserted by applicant is not a substitute for actual differences in properties. In re DeBlauwe, 22 USPQ 191. An apparently old composition cannot be converted into an unobvious one simply by the discovery of a characteristic one cannot glean from the cited prior art. Titanium Metals Corp. v. Banner, 227 USPQ 773.

Accordingly, the burden of proof is upon the Applicant to show that the instantly claimed subject matter is different from and unobvious over that taught by the prior art relied upon. In re Brown, 173 USPQ 65, 689; In re Best, 195 USPQ 430; In re Marosi, 21 USPQ 289, 293.

Conclusion

Claims 13-20 are pending. Claims 13-20 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Josephine Young whose telephone number is (703) 605-1201. The examiner can normally be reached on Monday through Friday, 9:00 a.m. to 6:00 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (703) 308-4624. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

JY
July 10, 2003



JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600